

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/421,810	04/13/95	CONRAD	A 20259-14

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LM32/0817 EXAMINER
HOLLOWAY III, E

ART UNIT	PAPER NUMBER
	2735

DATE MAILED: 08/17/95

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 08/421,810	Applicant(s) Conrad et al.
	Examiner Edwin C. Holloway, III	Group Art Unit 2735

THE PERIOD FOR RESPONSE: [check only a) or b])

- a) expires _____ months from the mailing date of the final rejection.
- b) expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response ^{after} to the final rejection, filed on 7-29-98, 5-19-98 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

The proposed amendment(s):

- will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- will not be entered because:
 - they raise new issues that would require further consideration and/or search. (See note below).
 - they raise the issue of new matter. (See note below).
 - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The amendments filed 5-19-98 will not be entered for the reasons stated in the attached response.

Applicant's response has overcome the following rejection(s):

- Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The request for reconsideration filed 7-29-98 is not persuasive for the reasons stated in the attached response.

- The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 49-71

- The proposed drawing correction filed on _____ has has not been approved by the Examiner.

- Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- Other


EDWIN C. HOLLOWAY, III
 PRIMARY EXAMINER
 ART UNIT 2735

EXAMINER'S RESPONSE

1. Please note that the examiner's art unit has changed from 2211 to 2735.

5 2. In response to the request for reconsideration filed 7-29-98, receipt of a copy of the claim chart is acknowledged, but the amendment filed 5-19-98 after Examiner's Answer has not been entered because the proposed claim(s) raise new issues which require further consideration or search (37 CFR 1.116). See also 10 MPEP 1207 and 2307.03.

3. Appellant argues that MPEP 1207 is not applicable because appellant's amendment was submitted for purposes of provoking an interference, not prosecution on the merits. This argument is not persuasive because the amendment includes new claims that 15 have not previously been considered with respect to the instant application for new issues such as enablement, adequate disclosure, new matter and other new issues which could result in a rejection on the merits.

Appellant argues that 37 CFR 1.606 provides clear basis for 20 determination of interfering subject matter by the examiner and no basis for the refusal for entering the amendment. This argument is not persuasive because 37 CFR 1.116(c) states no amendment can be entered as a matter of right in appealed cases.

MPEP 1207 indicates that amendments after appeal which introduce additional claims and "new issues" will not be entered, and since determination of interference is clearly a new issue, the amendment will not be entered. Further, MPEP 2307.03 states that 5 an amendment presenting claims to provoke an interference where the case has been closed to further prosecution as by final rejection or appeal is not entered as a matter of right, and it is proper to deny entry where the presented claims, as in the instant application, relate to an invention distinct from that 10 claimed in the application.

Appellant argues that the denial of entry is based on an improper determination that appellant is attempting to respond to the final rejection when to the contrary appellant is entitled to seek interference under 37 CFR 1.606. This argument is not 15 persuasive because 37 CFR 1.116(b) is not limited to amendments "attempting to respond to the final," but includes all amendments touching the merits presented after final or after appeal. Since the amendment includes new claims which must be considered on the merits of the instant applicant for the first time and because 20 interference is decided by the Board of Patent Appeals and Interferences, the amendment is considered to be directed to the merits. Further, 37 CFR 1.606 does not give appellant the right to make amendments which introduce additional claims and new issues after appeal.

4. Appellant argues that the examiner's contention that a "new search" would be required is clearly erroneous. This argument is not persuasive because consideration of the alleged interfering patent, the art cited in the patent, the different search areas listed on the patent, researching the areas searched for the instant application for the claims of the patent and updating prior searches, all constitute "new search" regardless of the assumption of validity.

5 5. The argument that the "new issue" of interference is important is not persuasive because such new issues do not comply with the requirements of 37 CFR 1.116. There is no statement in 10 37 CFR 1.606 that this rule provides an exception to the requirements of 37 CFR 1.116.

15 6. Appellant argues that the claim chart is not required under the rules. This argument is not proper because 37 CFR 1.607 requires appellant to explain how the interfering claims correspond to the count and the disclosure of the application when requesting an interference and the chart appears to have been the only explanation.

20 7. The reasons for non-entry stated in the advisory action mailed 6-8-98 are repeated below.

The amendment adds 30 new claims numbered 72-102 which were not earlier presented and are replete with limitations not earlier considered such as each receiver unit storing multiple

unique identity data streams received from multiple transmitter units, 16 data bits, a pair of start bits, a stop bit, transmitting both vertically and horizontally, etc. Therefore the amendment necessitates a new search, raises the issue of new matter, presents additional claims without canceling a corresponding number of finally rejected claims, raises the new issue of interference, and does not simplify the issues for appeal. Such amendments will not be entered as stated in MPEP 1207.

10 8. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

CONTACT INFORMATION

9. Please note that the examiner's art unit has changed from 2211 to 2735.

15 10. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2700 receptionist whose telephone number is (703) 305-3900.

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin Holloway whose telephone number is (703) 305-4818.

EH
08-14-98


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2735